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Gregory P. LaPointe Bachman & LaPointe, P.C. 900 Chapel Street, Suite 1201 New Haven, CT 06510-2802				
EXAMINER TRAN, THAO T				
ART UNIT		PAPER NUMBER		
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 121203

Application Number: 09/684,173
Filing Date: October 06, 2000
Appellant(s): KITTRELL, JAMES R.

Gregory LaPointe
For Appellant

EXAMINER'S ANSWER

MAILED
JAN 05 2004
GROUP 1700

This is in response to the appeal brief filed on November 19, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct, except of a type error in line 8 of the Summary of Invention. The element selected from the group consisting platinum, palladium, and mixtures thereof should be in an amount of between about 0.01 wt.% to about 5.0 wt.% , instead of 0.1 wt.% to about 5.0 wt.% (see instant specification, page 19, lines 5-18).

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because it does not appear how the breadth of claim 28 would materially different from that of claim 27.

(8) Claims Appealed

A substantially correct copy of appealed claim 28 appears on page 1 of the Appendix A to the appellant's brief. The minor errors are as follows: claim 28, line 1 "is", second occurrence should be changed to --in--.

(9) Prior Art of Record

6,086,749

Kramer et al.

9-2000

Upon further consideration, the rejection of claims 27-28 over Ohara (US Pat. 3,640,817) has been withdrawn.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC 102/§ 103

1. Claims 27-28 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kramer et al. (US Pat. 6,086,749).

Kramer teaches a catalyst composite, comprising a combination of silica, titania, tungsten oxide, and platinum (see col. 37, ln. 2-20). Kramer further teaches tungsten oxide (Group VIB metal) to be about 0.5 to about 50% by weight, preferably about 0.5 to about 30% by weight; platinum (Group VIII metal) about 0.1 to about 10% by weight; and that the total metal components would be about 0.1 to about 60% by weight of the total catalyst (see col. 37, ln. 32-

51), overlapping the instantly claimed ranges. Thus, the total weight of silica and titania would inherently be about 40 to about 99.9%, overlapping the instantly claimed ranges.

Although Kramer is silent with respect to the weight percent of silica and titania separately, the weight percent of silica and titania each would be inherently overlapping the instantly claimed ranges, because the silica weight is presently claimed to be about 0.1% to about 70% whereas the titania weight about 30% to about 90%.

Kramer, however, does not specify the individual weight percent of titania or silica. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have determined the weight percent of silica and titania needed to provide the properties desired in the catalyst. Moreover, Applicant has not shown unexpected results obtained by using the particular weight percent components in the catalyst.

(11) Response to Argument

1. Upon further consideration, the rejection of the claims over O'Hara has been withdrawn. Therefore, the arguments with respect to the reference of O'Hara are moot.
2. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant alleges that the examiner has reached the conclusion using hindsight reconstruction based on Applicant's own disclosure, whereas the prior art does not teach or suggest the combination of elements in the specific weight percentages claimed in claim 27. Appellant contends that Kramer '749 teaches an inorganic support of silica or titania individually, not in combination as recited in the instant claim 27. However, Kramer does teach the inorganic oxides individually or in combination as illustrated in col. 37, lines 16-20. Kramer further illustrates the inorganic oxides in combination, such as silica-alumina, silica-magnesia, alumina-magnesia, and the like which would include a combination of silica and titania.

With respect to the weight percent of titania and silica, since Kramer teaches the total weight percent of the metal components to be about 0.1 to about 60%, based on the total weight of the inorganic oxide support plus the metal oxides (see col. 37, lines 35-37), the total weight of titania and silica would inherently be about 40 to about 99.9%.

Although Kramer does not specify the weight percent of silica and titania individually, the mixtures disclosed by the reference would be expected to include components in amounts within the weight percents set forth in the instant claims. The reason is that the reference does not limit the weight percent of silica and/or titania to be used.

In one example, let's take the weight of titania to be about 30% and that of silica to be about 10%, the total weight percent of titania and silica would be about 40%. In another example, let's take the weight of titania to be about 90% and that of silica to be about 9%, the total weight percent of titania and silica would be about 99%. These figures satisfy the requirements of the instantly claimed ranges. Therefore, the ranges Kramer teaches do overlap the instantly claimed ranges

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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December 13, 2003

Conferees:

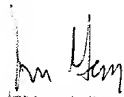
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